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EXAMINER	
REESE, DAVID C	
ART UNIT	PAPER NUMBER
3677	

DATE MAILED: 05/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/779,433

Applicant(s)

FUHRMAN ET AL.

Examiner

David C. Reese

Art Unit

3677

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/29/2006 has been entered. Consequently, the following is the current listing of claims in the instant application:

Status of Claims

- Claims 1 and 10 were amended.
- Claims 1-17 are pending.
- A replacement drawing (Fig. 5) was filed for entry.

Drawings

[1] The drawing(s) were previously objected for informalities. In view of Applicant's replacement drawing(s) submitted on 3/29/2006, all previous objection(s) to the drawings have been withdrawn. Accordingly, the changes have been entered.

Claim Objections

[2] Claim 10 is objected to because of the following informalities: It appears as if, on page 5, line 5, "first housing," should be "second housing." Appropriate correction is required.

Claim Rejections - 35 USC § 103

[3] The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject

Art Unit: 3677

matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

[4] Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, 5,349,725, in view of case law, and in further view of Keller, US-1,807,293.

Although the invention is not identically disclosed or described as set forth 35 U.S.C. 102, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a designer having ordinary skill in the art to which said subject matter pertains, the invention is not patentable.

As for Claim 1, Levy teaches of a jewelry fastener comprising a first housing (6), the first housing including a distal end and a proximal end, the proximal end containing a permanent magnet (10) having a facing surface,

a safety catch (12),

second housing (4), the second housing (4) having first and second external surfaces; the second housing (4) further including an opening (to the right of 8) located on a front section of said second housing (4), a permanent magnet (8) having a facing surface located on a middle section of said second housing (4),

a slot (16),

said permanent magnets (10, 8) both being magnetized so that the line of greatest magnetic force is perpendicular to the facing surfaces, said facing surfaces of the permanent magnets (10, 8) attracted to each other when positioned proximate to each other and within the field of magnetic forces,

whereby said safety catch (12) and has a protuberance (14) extending outwardly from the other end, the protuberance (14) having a free end (end of 14),

wherein the free end (end of 14) of the protuberance (14) enters the slot (16) to retain the first (6) and second (4) housings together.

Levy, however, teaches of the safety catch being located on the distal end of the second housing, and the slot located on a rear section of the first housing instead of the safety catch being on the first housing and the slot on the second housing, as currently claimed. Secondly, Levy does not show that the safety catch has a pivoted end; as well as the slot of the second housing passing fully through the second housing to be accessible through both said first and second external surfaces, and said safety catch being rotatable about the pivotal mounting.

With respect to the former issue above, note that it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70. See also, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). In the instant case, it would have been obvious and involving only routine skill in the art to rearrange the safety catch and slot of the second and first housings, respectively, to have the safety catch on the first housing (6) and the slot on the second housing (4), as it appears that the invention would perform equally as well.

With respect to the latter issues above, Keller teaches of a jewelry fastener (Fig. 1) that possesses a safety catch (6) with a pivoted end (5), as well as a slot (19) passing fully through a second housing (11) to be accessible through both said first and second external surfaces, and said safety catch (6) being rotatable about the pivotal mounting (5).

Art Unit: 3677

At the time of invention, it would have been obvious to one of ordinary skill in the art to modify the jewelry fastener as taught by Keller, to incorporate a pivoting safety catch and a slot passing fully through the housing, in order to provide an alternative and/or additional securement to the clasp via a pivoting latch that goes more substantially into the second housing as to help render rapid and easy securing of the parts in locked relation (line 21-23) and deter accidental detachment between the two clasp members, as stated by Keller, in col. 1, beginning with line 15, "...provide an absolutely reliable fastening and locking means to positively secure the parts and guard against accidental unfastening or theft".

Re: Claim 2, Levy teaches wherein the first housing (6) has an opening and the permanent magnet (8) in the second housing (4) fits into the opening in the first housing (6) to place the permanent magnets (10, 8) in close proximity to each other to magnetically attract each other (after rearranging the placement of 12 onto 6 and 16 onto 4).

Re: Claim 3, Keller teaches wherein the safety catch (6) has a straight member (6) pivotally (via 5 of Keller) mounted to the first housing and the protuberance (7 of Keller) extends from the free end (6) thereof at an angle of about 90 degrees (7 of Keller).

Re: Claim 4, Keller teaches wherein the slot (19) has an outer surface having at least one indentation and said protuberance (7) has at least one protruding nib (below 9) that snaps into the at least one indentation when said safety catch (6) is in said locked position to hold the first and second housings together.

Art Unit: 3677

Re: Claim 5, Keller teaches wherein said at least one indentation is one indentation that is located about equidistant between each of the first and second external surfaces of the second housing (8 in Fig. 3 of Keller).

“About” is not indefinite in as much as its meaning is not broad and arbitrary; rather, term is clear and flexible and “approximately” or “nearly.” *Ex parte Eastwood Brindle & Knob* (PO BdApp) 163 USPQ 316.

Re: Claim 6, Keller teaches wherein the indentation is formed in a spring steel material (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material, therefore, in this case, it would have been readily apparent to one skilled in the art to use a spring steel material for the indentation so that the effect of snapping may be enhanced).

Re: Claim 7, Keller teaches wherein the safety catch has a magnetically attractable material or magnet that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, “...fastener which will be simple, strong

Art Unit: 3677

and durable construction...” Thus, due to such; steel is indeed a material that can be considered a “magnetically attractable material”).

Re: Claim 8, Keller teaches wherein the magnetically attractable material comprises a magnet or steel plate affixed along an internal surface of said safety catch (see above).

Re: Claim 9, Keller teaches wherein the free end (end of 7) of the protuberance (7) extends beyond the depth of the slot (col. 2, line 70, “...keeper 7, which when the parts are in locked position is adapted to pass through the pair of openings 8...) thereby allowing the free end of the protuberance (end of 7) to protrude from the jewelry clasp. Further, with respect to the length of the protuberance and/or free end of said protuberance, it is pertinent to point out that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re Rinehart*, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) (“mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled.” 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Art Unit: 3677

As for Claim 10, Levy in view of Keller teach of a method of completing the connection of a jewelry clasp comprising the steps of:

providing a first housing (6 of Levy) having a jewelry chain (3) affixed thereto, a pair of oppositely disposed external surfaces and having magnetic surface (10 of Levy), and a safety catch (6 of Keller in view of rearranging obviousness),

providing a second housing (4 of Levy) having a jewelry chain affixed thereto and having a magnetic surface (8 of Levy), a slot (19 of Keller in view of rearranging obvious) and an opening (to the right of 8 of Levy);

joining the first (6 of Levy) and second (4 of Levy) housings together by aligning and facing the magnetic surfaces (10, 8 of Levy) facing each other)

providing the safety catch (6 of Keller) to be movable affixed to the second housing (4 of Levy) and adapted to be movable to a locked position; said safety catch (6 of Keller) having a free end (end of 7 of Keller);

providing a slot (19 of Keller) in the first housing (4 of Levy) to extend entirely through the second housing (4 of Levy) and opening through both of said oppositely disposed external surfaces;

engaging the first (6 of Levy) and second (4 of Levy) housings together to align the magnetic surface (10 of Levy) of the first housing (6 of Levy) with the magnetic surface (8 of Levy) of the second housing (4 of Levy) abutted together to complete the connection of the first (6 of Levy) and second housings (4 of Levy) together; and

moving the safety catch (6 of Keller) to the locked position wherein the free end (end of 7 of Keller) of the safety catch (6 of Keller) enters into the slot (19 of Keller) through the opening in either of the oppositely disposed external surfaces.

Re: Claim 11, Levy shows wherein the step of providing a first housing (6) and the step of providing a second housing (4) comprises providing a first housing (6) and a second housing (4) having permanent magnets (10, 8) disposed therein forming the magnetic surfaces.

Re: Claim 12, Keller shows wherein the step of providing a safety catch (6) comprises providing a safety catch (6) having a nib (below 9) extending outwardly therefrom and said step of providing a slot (19) comprises providing a slot (19) having an indentation formed therein and said step of moving the safety catch (6) to a locked position comprises engaging the nib (below 9) within the indentation (7 into 8 in Fig. 2 of Keller).

Re: Claim 13, Keller shows wherein the step of providing a safety catch comprises providing a safety catch having a magnet or magnetically attractable material that is attracted to the permanent magnet located in the second housing (Note that it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious engineering design choice. *In re Leshin*, 125 USPQ 416. It is also common knowledge to choose a material that has sufficient strength, durability, flexibility, hardness, etc. for the application and intended use of that material. Therefore, in this case, assuming that the device as presented by Keller is made of a metal, preferably steel, since as Keller states, "...fastener which will be simple, strong and durable construction..." Thus, due to such; steel is indeed a material that can be considered a "magnetically attractable material").

Re: Claim 14, Keller shows wherein the step of providing a safety catch comprises providing a safety catch (6) having a nib extending outwardly therefrom (8 in Fig. 2) and said step of moving the safety catch to a locked position comprises moving the safety catch to a position where the magnetically attractable material is attracted to the permanent magnet in said second housing (Levy in view of Keller, also; see Claim 13 rejection).

Re: Claim 15, Keller shows wherein the step of providing a safety catch comprises providing a safety catch (6) having a magnetically attractable material (Claim 13) located on a surface that overlies one of the oppositely disposed external surfaces of the second housing (15 and above in Fig. 2).

Re: Claim 16, Keller shows wherein the step of providing a safety catch comprises providing a safety catch (6) having the magnet or magnetically attractable material (Claim 13) located on a surface that abuts against an internal surface of the slot formed in the second housing (7 into 8 in Fig. 2).

Re: Claim 17, Keller shows wherein the step of moving the catch (6) to the locked position allows the free end (end of 7) of the protuberance to extend beyond the depth of the slot (col. 2, line 70, "...keeper 7, which when the parts are in locked position is adapted to pass through the pair of openings 8...") thereby allowing the free end of the protuberance (end of 7) to protrude from the jewelry clasp. Further, with respect to the length of the protuberance and/or free end of said protuberance, it is pertinent to point out that those of ordinary skill in the art would appreciate that a modification such as a mere change in size of a component would be obvious. A change in size is generally recognized as being within the level of ordinary skill in the art. *In re Rose*, 105 USPQ 237 (CCPA 1955). See also, MPEP § 2144.04 which states: *In re*

Art Unit: 3677

Rinehart, 531 F.2d 1048, 189 USPQ 143 (CCPA 1976) ("mere scaling up of a prior art process capable of being scaled up, if such were the case, would not establish patentability in a claim to an old process so scaled." 531 F.2d at 1053, 189 USPQ at 148.). In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device.

Conclusion

[5] THIS ACTION IS NON-FINAL

[6] Any inquiry concerning this communication or earlier communications from the examiner should be directed to David C. Reese whose telephone number is (571) 272-7082. The examiner can normally be reached on 7:30 am-6:00 pm Monday-Thursday.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J.J. Swann can be reached at (571) 272-7075. The fax number for the organization where this application or proceeding is assigned is the following: (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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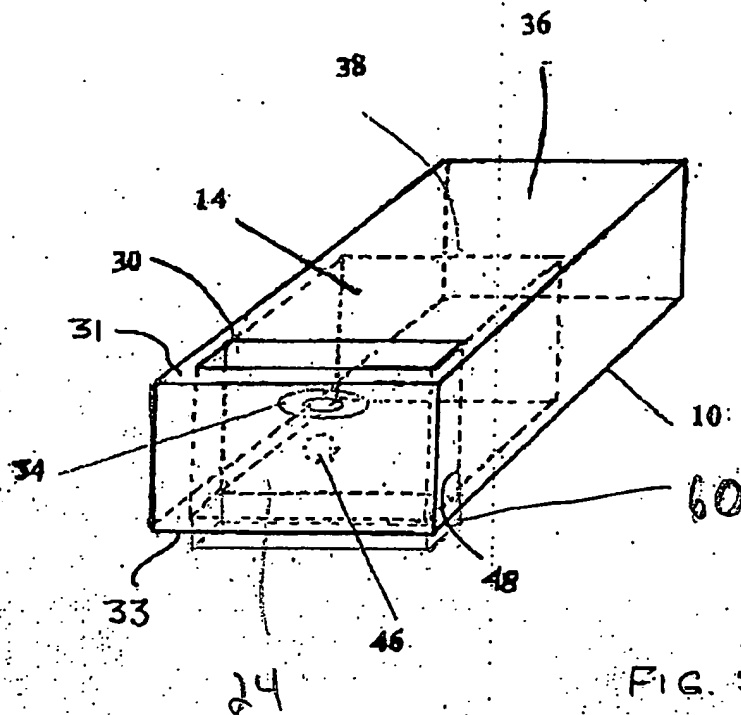
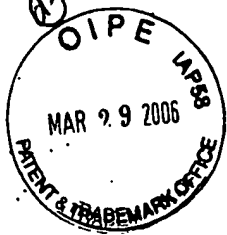
David Reese
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ROBERT J. SANDY
PRIMARY EXAMINER

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REPLACEMENT DRAWING



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FIG. 5